

REMARKS

In the Office Action¹, the Examiner rejected claims 1-12, 15, 16, 19, and 20 under 35 U.S.C. § 112, second paragraph; rejected claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Eberlein et al. (U.S. Patent No. 6,524,758, hereafter "Eberlein") in view of Okamoto et al. (U.S. Patent No. 4,585,319, hereafter "Okamoto) and Oka (U.S. Patent No. 4,588,617); and rejected claims 13-20 under 35 U.S.C. § 103(a) as being unpatentable over Okamoto in view of JP 2001-284769 (hereafter "JP'769").

Applicants have amended claims 6, 12, 13, 15-17, 19, and 20; canceled claims 14 and 18; and added new claims 21-24. Claims 1-13, 15-17, and 19-24 are pending in the above captioned application. Support for the amendments to claims 6 and 12 may be found in the specification, for example, at page 22, lines 9-10, and support for the amendments to claims 15 and 19 may be found, for example, at page 21, line 28 - page 22, line 10. In addition, support for the amendments to claims 16 and 20 may be found, for example, at page 22, line 26. The amendments to claims 13 and 17 incorporate the subject matter of corresponding dependent claims 14 and 18. Support for new claims 21 and 23 may be found, for example, at page 14, lines 12-18, and support for new claims 22 and 24 may be found, for example, at page 22, lines 19-22.

Applicants respectfully traverse the Examiner's rejection of claims 1-12, 15, 16, 19, and 20 under 35 U.S.C. § 112, second paragraph.

To the extent that the Examiner's argument is understood, the Examiner appears to contend that claim 1 is "a method of manufacturing," and that there are "two methods

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

of manufacturing a circuit." Office Action at 2. The Examiner states that the two methods form a pattern where "one uses a charged particle and the other uses a metal containing particle." *Id.* Further, according to the Examiner "[both] methods of manufacturing an electronic circuit use an electroless plating however the use of the plating with a non-metallic image is not shown in the specification." *Id.*

Applicants respectfully submit that claim 1 recites "forming a first pattern and forming a second pattern." Forming the second pattern includes "forming a second visible image on the second photosensitive base on which the electrostatic latent image is formed, by bringing metal-containing charged particles essentially made of resin and containing metal particulates into electrostatic adhesion with the second photosensitive base," (*Id.*, emphasis added). Forming the second pattern also includes "forming a conductor metal layer by electroless plating." *Id.* Contrary to the Examiner's statements at page 2 of the Office Action, claim 1 does not recite the Examiner alleged "plating with a non-metallic image." Applicants therefore respectfully submit that the Examiner's statements with respect to claim 1 are misplaced.

With respect to claims 3 and 9, the Examiner contends that the "B-staged thermosetting resist is indefinite." Office Action at page 2. Applicants respectfully disagree. The term "B-staged thermosetting resin," would be understood by one having ordinary skill in the art and is clearly described, for example, at page 11, line 23-26 of the specification.

The Examiner rejected claims 6, 15, 16, 19, and 20 under 35 U.S.C. § 112, second paragraph. Applicants disagree with the Examiner's allegations that claims 6, 15, 16, 19, and 20 are indefinite. To advance prosecution of this case, however,

Applicants have amended claims 6, 15, 16, 19, and 20 to more appropriately define their invention.

Accordingly, claims 1, 3, 6, 9, 15, 16, 19, and 20 more than adequately “meet[] the threshold requirements of clarity and precision” (M.P.E.P. § 2173.02). Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-12, 15, 16, 19, and 20 under 35 U.S.C. § 112, second paragraph.

Applicants respectfully traverse the Examiner’s rejection of claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Eberlein in view of Okamoto and Oka. To establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine references. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim elements. See M.P.E.P. § 2143. Moreover, the requisite teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 706.02(j).

Claim 1, for example, is not obvious Eberlein in view of Okamoto and Oka. In particular, the applied references at least fail to teach or suggest “forming a first visible image on the first photosensitive base on which the electrostatic latent image is formed, by bringing charged particles essentially made of resin into electrostatic adhesion with the first photosensitive base,” (emphasis added) as recited in claim 1.

The Examiner apparently concedes that Eberlein and Okamoto fail to teach or suggest at least "charged particles essentially made of resin," as recited in claim 1, and instead relies on Oka, allegedly for teaching "the fluorescent substance in a toner composition." Office Action at 3. Applicants note that Oka discloses "spherical particles of cured epoxy resin" (col. 1, lines 39-41), and that these particles may be used as "a toner for electrostatic copiers" (col. 1, lines 58-62). Mere disclosure of a "toner for electrostatic copiers," (*Id.*) however fails to teach or suggest the claimed "charged particles essentially made of resin" (emphasis added), as recited in claim 1. Claim 1 is thus allowable over the Examiner's proposed combination of Eberlein, Okamoto and Oka for at least this reason.

Claim 7, though of different scope, recites similar limitations to claim 1, and is thus also allowable for at least the above discussed reasons. Furthermore, claims 2-6, and claims 8-12, respectively depend from independent claims 1 and 7, and are thus allowable at least due to their corresponding dependencies from claim 1 and 7. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection rejected of claims 1-12 under 35 U.S.C. § 103(a).

The Examiner rejected claims 13-20 under 35 U.S.C. § 103(a) as being unpatentable over Okamoto in view of JP'769. Applicants respectfully disagree.

Amended claim 13 incorporates subject matter from dependent canceled claim 14. The Office Action did not address the subject matter of claim 14, and thus, claim 13, as amended, is allowable for at least this reason. Moreover, Applicants note that both Okamoto and JP'769 are silent as to electroless plating, and thus both certainly fail

to teach or suggest the claimed “an electroless plating apparatus,” as recited in amended claim 13.

Amended claim 17, though of different scope, recites similar limitations to claim 13, including “an electroless plating apparatus,” and is therefore also allowable at least for the reasons discussed above with respect to claim 13. Furthermore, claims 15, 16, 19, and 20 are allowable at least due to their dependence from claims 13 and 17, respectively. Applicants have canceled claims 14 and 18, rendering the Examiner’s rejection of these claims moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claims 13- 20 under 35 U.S.C. § 103(a).

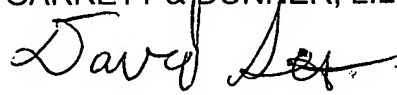
Furthermore, new claims 21 and 22 and new claims 23 and 24 respectively depend from independent claims 1 and 7, and are also allowable at least due to their respective dependencies. Accordingly, Applicants respectfully submit that all pending claims 1-13, 15-17, and 19-24, are in condition for allowance.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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